

Application No.: 09/325963

Case No.: 54664US002

REMARKS

Claims 1-16, 18-24, 29-33, and 35 are pending in this application. Claims 1-12 and 18-24 have been withdrawn from consideration. Claims 13-16, 29-33, and 35 have been rejected. By this response, Applicants amend claims 29 and 31, and cancel claims 13-16 and 35. New claim 36 has been added. Applicants respectfully request reconsideration of the rejected claims in light of the amendments and the following remarks.

The Examiner has asserted that the reply filed on September 2, 2004 was not fully responsive to the prior Office Action because the Examiner believes that the "scope of the amended independent claim 29 is structurally distinct from the originally claimed invention." In the Examiner's view, the amendment adding the limitation that "at least one of the outer skin layers has sufficient thickness to prevent rupture of the outer skin layer" changed the claim such that it is no longer directed to a "breathable" film. Thus, the Examiner asserts that the amended claims were directed to a nonelected invention. In accordance with MPEP 821.03, it appears that Applicant's previous amendment was not entered ("An amendment canceling all claims drawn to the elected invention and presenting only claims drawn to the nonelected invention should not be entered.").

It is Applicants' view that claim 29 as previously amended was clearly directed to breathable foams and thus drawn to the elected invention. However, since the present invention properly includes embodiments in which both of the outer layers may be thin, Applicants are now submitting a corrected version of the amendment to claim 29 that has no limitation regarding the thickness of the outer skin layer. Since it appears that the previous amendment was not entered, the present amendment shows the changes based on the claims as they existed prior to the amendment submitted on September 2, 2004.

Claim Amendment

Independent claim 29 has been amended to recite that the article includes a three-layer structure comprising a core foam layer and two non-foam outer skin layers, wherein the skin layers are melt-bonded to the underlying foam layer. The outer skin layers have also been more precisely defined. Support for this amendment is found, for example, on page 6, lines 1-14; page

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7, lines 15-21; page 14, lines 26-32; and page 15, lines 1-10 of the present specification. Dependent claim 31 has been amended to correct the dependency so that it now depends from claim 2. New claim 36 recites that the foam cell of the inner core layer was ruptured by stretching. Support for this claim is found, for example, on pages 6-7, 10, and 16 of the specification. No new matter is added by this amendment.

§103 Rejection of claims 13-15, 31, and 35 as being unpatentable over Lindquist

Claims 13-15, 31, and 35 were rejected under 35 U.S.C. § 103(a) as obvious over Lindquist et al. (U.S. Patent No. 3,665,918). All of these claims, with the exception of claim 31, have been canceled. Claim 31 has been amended to depend from claim 29. Accordingly, this rejection may now be withdrawn.

§103 Rejection of claims 13-16 as being unpatentable over Walther

Claims 13-16 and 35 were rejected under 35 USC § 103(a) as being unpatentable over Walther (U.S. Patent No. 5,905,097). All of these claims have been canceled so this rejection may now be withdrawn.

§103 Rejection of claims 29, 30, 32, and 33 as being unpatentable over Lindquist in view of Pufahl

Claims 29, 30, 32, and 33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lindquist (U.S. Patent No. 3,665,918) in view of Pufahl (U.S. Patent No. 4,169,184).

Applicants respectfully traverse this rejection as applied to the amended version of the claims.

In order to establish a *prima facie* case of obviousness, the Patent Office must demonstrate that (1) there is a suggestion or motivation in the prior art to modify or combine reference teachings, (2) one skilled in the art would have had a reasonable expectation of success in making the modification or combination, and (3) the prior art reference(s) disclose all of the claim limitations. The fact that one of ordinary skill in the art would have had the capability to modify the method disclosed in the prior art reference(s) is not sufficient. MPEP 2143.01. The prior art reference(s) must provide a motivation or reason for making the changes. MPEP 2142; *Ex parte Chicago Rawhide Manufacturing Co.*, 226 USPQ 438 (PTO Bd. App. 1984)

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Claim 29 has been amended to be directed to an article having a three-layer structure comprising a core foam layer and two outer skin layers, wherein the skin layers are melt-bonded to the core foam layer. As acknowledged by the Examiner, Lindquist fails to describe a three-layer ABA structure (see Paper No. 14, P. 10). However, the Examiner has previously asserted that a three-layer structure would have been obvious because Pufahl describes a foam substrate coated with a pressure sensitive acrylic resin adhesive. The Examiner concludes in Paper No. 14 that it would have been obvious to use the foam layer of Lindquist and coat it with adhesive on both sides as described by Pufahl to provide a three-layer structure as claimed. However, the amended version of claim 29 recites that the skin layers are melt-bonded to the core foam layer. Even if it would have been obvious, as suggested by the Examiner, to coat adhesive onto the foam as described by Pufahl, there is nothing in Pufahl or Lindquist that teaches or suggests or provides any motivation for a foam substrate having two outer skin layers comprising a thermoplastic material, elastomer, or semi-crystalline polymer, wherein the outer layers are melt-bonded to the inner foam core. As explained on page 3 of the specification, "melt-bonded means adhering adjacent layers by bringing them into contact while both are in a molten state, e.g. by extrusion." Pufahl merely describes coating an adhesive onto a foam; it does not describe coextrusion of the outer layers with the foam core. Since Pufahl does not provide the elements that are lacking from Lindquist, these references even in combination fail to teach or suggest all of the claim limitations. Thus, this combination of references does not render the claimed invention obvious.

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Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully submit that the application is in condition for allowance. Reconsideration of the application is requested.

All communications in this case should be direct to the undersigned. If the Examiner believes a telephone discussion would be helpful to resolve any of the outstanding issue in this case, the Examiner is encouraged to call the undersigned at the number listed below.

Respectfully submitted,

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Date

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